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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/462,214	01/04/2000	JUNJI KODEMURA	10936-38	4799

7590 09/24/2003

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EXAMINER

JACKSON, MONIQUE R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/462,214

Applicant(s)

KODEMURA, JUNJI

Examiner

Monique R Jackson

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 09 September 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached.

3. ☒ Applicant's reply has overcome the following rejection(s): See attached.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1,2,4-6,8-12 and 14-29.

Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Art Unit: 1773

### ADVISORY ACTION

Continuation of Item No. 2. NOTE: The proposed amendments will not be entered because they raise new issues that would require further consideration and/or search, they possibly raise the issue of new matter, and they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal, wherein it is noted that the proposed amendments claim an embodiment that was not previously presented wherein there appears to be no clear support for a polyphenylene ether resin having the instantly claimed functional groups other than a maleic anhydride group.

Continuation of Item No. 3. NOTE: Applicant's arguments have overcome the rejection of Claims 2, 3, and 12 under 35 U.S.C. 103(a) over Kaneda in view of Sugio wherein it is noted that Sugio does not disclose that the cyclic-containing polymer has a functional group in a proportion as instantly claimed.

Continuation of Item No. 5. NOTE: The Applicant's arguments filed 9/9/03 have been considered but are not persuasive in terms of Kaneda in view of Sugio with respect to Claims 1, 6, 8-11 and 14-29 given that the proposed amendments have not been entered, and in terms of Kaneda in view Kataoka et al. The Examiner notes that the Applicant appears to argue the references individually as opposed to in combination as presented in the rejections. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

Art Unit: 1773

invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference Kaneda et al teach a semiconductor device comprising a semiconductor adhered to a substrate via an anisotropic conductive adhesive comprising an electrically conductive filler and an insulating matrix resin, wherein Kaneda et al teach that the insulating matrix resin may be any suitable thermoplastic or thermosetting resin but do not teach a cyclic structure-containing thermoplastic polymer as instantly claimed. Hence, though Kaneda et al disclose phenoxy resin, acrylic rubber and epoxy resin, Kaneda et al provides a suggestion of utilizing any suitable thermoplastic adhesive resin. Further, the secondary references provide teachings of the instantly claimed cyclic structure-containing thermoplastic polymers, their use as adhesives or insulating layers in electronic devices and the improvements provided in selecting these polymers. Hence, the secondary references provide motivation for one skilled in the art to select these polymers for use in the invention taught by Kaneda et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 09/462,214

Page 4

Art Unit: 1773

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
**MONIQUE R. JACKSON**  
**PRIMARY EXAMINER**

Technology Center 1700  
September 17, 2003